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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,348	10/14/2003	Dale W. Malik	190250-1330	7196
38823 7590 04/13/2009 AT&T Legal Department - TKHR Attn: Patent Docketing One AT&T Way Room 2A-207 Bedminster, NJ 07921				
EXAMINER				
HUSSAIN, TAUQIR				
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2452				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/686,348

**Applicant(s)**

MALIK, DALE W.

**Examiner**

TAUQIR HUSSAIN

**Art Unit**

2452

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 and 23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date 02/17/2009
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/16/2009 has been entered.

### ***Response to Amendment***

2. This office action is in response to amendment /reconsideration filed on 02/16/2009, the amendment/reconsideration has been considered. Claims 1-2, 4-5, 7-11 and 16-20 have been amended, claim 22 have been canceled and claim 23 have been newly added. Claims 1-21 and 23 are pending for examination, the rejection cited as stated below.

### ***Response to Arguments***

3. Applicant's arguments have been fully considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. As to claims 1, 5, 10, 14, 19 and 20 are rejected under 112, 1<sup>st</sup> paragraph because there is no supporting evidence found in the specification for the limitation "indicating, **by first recipient**, that the **IM** message originated from sender". At best Examiner found the evidence of said limitation performed by the "**system**" and not by the first recipient (page 35 first paragraphs in the original specification).

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1-3, 5, 9-12, 14 and 18-20 are rejected under 35 U.S.C 103(a) as being unpatentable over Lee et al. (Pub. No. US 2003/0233265 A1), hereinafter "Lee" in view of Penner et al. (Patent. No.: US 7,328,247 B2), hereinafter "Penner".

6. As to claims 1 and 10, Lee discloses, receiving an instant messaging (IM) message from a sender to a first recipient (Lee, [0057, lines 1-4], where Instant Message is sent to a user who could be the first user to receive the IM message);

waiting a predefined time interval for an input from the first recipient, the input being responsive to the IM message (Lee, [0060, lines 3-5], where predetermined time interval is disclosed);

determining whether input from the first recipient is received during the predetermined time interval (Lee, [0060, lines 5-7], where agent determines if the if time is exceeded for response); and

in response to determining that no input from the first recipient is received during the predetermined time interval (Lee, [0060, lines 5-7], where agent determines if the time is exceeded for response).

Lee however is silent on disclosing explicitly, prompting the sender to forward the instant message from the first recipient to a second recipient and indicate, by the first recipient, that the IM message originated from the sender.

Penner, however discloses a similar concept where, prompting the sender to forward the instant message from the first recipient to a second recipient and indicating, by the first recipient, that the IM message originated from the sender (Penner, Col.4, lines 62-67 and Col.5, lines 1-22, where IM server appliance 210 permits the transfer of an IM message from a first recipient user to a second recipient and obviously header information, parameters or user ID can indicate the original sender of the message. Penner further discloses that this transferring mechanism can be automated in response to user-defined settings which means sender may have a setting which may require the first recipient to forward the message to second recipient or first recipient may ask for permission from sender before transferring the message to second recipient etc. user attributes and user-defined setting are well known in the art to control the specific application function on behalf of recipient, sender or user).

Therefore it would have been obvious to one ordinary skilled in the art at the time the invention was made to combine the teachings of Lee with the instant messaging concepts of Fostick, provides a IM server appliance also includes access control lists for

selectively providing client computer processing systems access to the plurality of public IM services on at least one of a group and per-user basis.

7. As to claims 5 and 14, Lee and Penner disclose the invention substantially as independent claims 1 and 10 above, including, receiving an instant messaging (IM) message from a first sender to a recipient (Lee, [0057, lines 1-4], where Instant Message is sent to a user who could be the first user to receive the IM message);

determining whether input from the first recipient is received during a predetermined time interval (Lee, [0060, lines 5-7], where agent determines if the if time is exceeded for response);

in response to determining that no input is received during the predetermined time interval (Lee, [0060, lines 5-7], where it is established that agent determines if the if time is exceeded for response) determining whether the first recipient is engaged in an IM chat session with a second sender (Lee, [0048, lines 3-7], where invitee/recipient has the status indicator that he will not attend or will attend or busy with other meetings, since it is well known in the art to that status can be customize as per user preferences, therefore user can select the status option to display as busy chatting with 2<sup>nd</sup> or 3<sup>rd</sup> user); and

in response to determining that the first recipient is engaged in an IM chat session with the second sender, replying to the IM message in response to determining that the recipient is engaged in the IM chat session with the second sender (Lee, [0048, lines 3-7], where invitee/recipient has the status indicator that he will not attend or will attend or busy with other meetings, since it is well known in the art to that status can be

customize as per user preferences, therefore user can select the status option to display as busy chatting with 2<sup>nd</sup> or 3<sup>rd</sup> user), prompting the sender to forward the instant message from the first recipient to a second recipient and indicating, by the first recipient, that the IM message originated from the sender (Penner, Col.4, lines 62-67 and Col.5, lines 1-22, where IM server appliance 210 permits the transfer of an IM message from a first recipient user to a second recipient. Penner further discloses that this transferring mechanism can be automated in response to user-defined settings).

8. As to claim 19 and 20 are rejected for the same rationale as applied to claim 1, 5, 10 and 14 above.

9. As to claims 2 and 11, Lee and Penner disclose the invention substantially as in parent claims 1 and 10 above, including, providing a message indicating the first recipient's unavailability to engage in an IM chat session (Lee, [0045, lines 8-10], where displaying status of user being taking a vacation day is indication that user's unavailability to chat on that particular day).

10. As to claim 9 and 18 are rejected for the same rationale as applied to claims 2 and 11.

11. As to claims 3 and 12, Lee and Fostick disclose the invention substantially as in parent claims 1 and 10 above, including, providing a message requesting the sender to wait for a predetermined time period (Lee, [0012], where response to a predetermined time is disclosed which means there is a waiting period for response).

12. Claims 4, 8, 13 and 17 are rejected under 35 U.S.C 103 (a) as being unpatentable over Lee and Penner in view of Murphy et al. (Pub. No.: US 2007/0274497 A1), hereinafter "Murphy".

13. As to claims 4 and 13, Lee and Penner disclose, the invention substantially as in parent claim 1 and 10. Lee and Penner however are silent on disclosing, "Periodically providing messages" or "the messages periodically being provided at predefined time intervals" or "each message indicating the first recipient's unavailability to engage in an IM chat session during the corresponding predefined time interval".

Periodically providing messages (Murphy, [0066], where message is queried periodically for presence detection to call destination computer system), the messages periodically being provided at predefined time intervals (Murphy, where message is queried periodically for presence information at predefined time i.e. every 15 sec), each message indicating the first recipient's unavailability to engage in an IM chat session during the corresponding predefined time interval (Murphy, [0066], where status and user's availability is determined by status determination).

Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to combine the teachings of Lee and Penner with the collaborated system (call and presence detection) of Murphy in order to provide an electronic communication associated with the phone call is sent across the network to the one or more external online service provider systems conditioned on whether the identity is determined to be available to receive the electronic communication.



14. As to claims 8 and 17 are rejected for the same rationale as applied to claims 4 and 13 above.

15. Claims 6-7 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee and Penner in view of Manabe.

16. As to claims 6 and 15, Lee and Penner disclose the invention substantially as in parent claims 5 and 14 above. Lee and Penner however, are silent on disclosing explicitly, waiting a predefined time interval prior to replying to the IM message. Manabe, however discloses, waiting a predefined time interval prior to replying to the IM message (Manabe, Abstract, where detection of a keystroke or keyword, judges user status based on the status of the user terminal means when recipient replies to a message, a sender can see the status of the recipient as recipient is writing, therefore, sender can wait until recipient finish writing to conduct a smooth conversation in real time).

Therefore, it would have been obvious to one ordinary skilled in the art at the time the invention was made to combine the teachings of Lee and Penner with the teachings of Manabe in order to provide a real-time status of a user called be a keyword is reported to a users engaged in IM chat session.

17. As to claims 7 and 16, Lee, Penner and Manabe disclose the invention substantially as in parent claims, 5 and 14, including, indicating to the first sender that

the first recipient is engaged in an IM chat session with the second sender (Manabe, Col.1, lines 55-60, where another application could be a chat session with second user).

18. Claims 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee and Penner in view of Matsumoto et al. (Patent No.: US 4, 639, 889), hereinafter "Matsumoto" and further in view of "XMPP Instant Messaging" by Network working group, hereinafter "NWG".

19. As to claim 21, Lee and Penner disclose the invention substantially as in parent claim 20. Lee and Penner are however silent on, a timer configured to track elapsed time from a receiving of an IM message.

Matsumoto however discloses the similar concept of "a timer configured to track elapsed time from a receiving of an IM message (Matsumoto, Col.13, lines 26-35, where timer is set on the response time monitoring timer to track the elapsed time of a response).

Therefore, it would have been obvious to one of the ordinary skilled in the art at the time the invention was made to combine the teachings of Lee and Penner with the teachings of Matsumoto in order to provide a data communication control system in which data communication between a main control assembly and specific terminal units is effected according to the main program of the assembly and which also permits data communication between the main control assembly and other terminal units not included in the sequential processing under the main program.

Lee, Penner and Matsumoto however are silent on disclosing explicitly, "the reply logic comprises message-generation logic configured to generate a message, the message being indicative of the first recipient's unavailability to engage in and IM chat session."

NWG however discloses the scope of availability and unavailability of status as claimed in instant application where, "the reply logic comprises message-generation logic configured to generate a message, the message being indicative of the first recipient's unavailability to engage in and IM chat session." (NWG, paragraphs, 4.3-4.6, where various scenarios are disclosed to generate a message showing user's various status e.g. away, busy, do not disturb, extended away etc.)

Therefore, it would have been obvious to one ordinary skilled in the art at the time the invention was made to combine the teachings of Lee, Penner and Matsumoto with the teachings of NWG in order to provide a system for promoting smooth communications in a chat system, where customizing the user statuses will make the communication easier among plurality of users.

20. As to claim 23, Lee, Penner, Matsumoto and NWG discloses the invention substantially as in parent claim 20 above, including, comprising a processor configured to execute logic stored in the memory component (Penner, Fig.2, elements-130, where server has a processor and data is stored in a memory, Col.2, lines 9-20, where server provides subscriber with varies forms of on-lines services including digital communication).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAUQIR HUSSAIN whose telephone number is (571)270-1247. The examiner can normally be reached on 7:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571 272 3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. H./  
Examiner, Art Unit 2452

/Dohm Chankong/  
Examiner, Art Unit 2452